

Serial No.: 09/690,366

Docket No. 1005.6
Customer No. 53953**REMARKS**

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 20, 25 and 30 have been amended. Antecedent basis is located throughout Applicant's specification and the original claims. No new matter has been added. Claims 1, 4-6, 9-11, 14, 15, 18, 23 and 28 have been cancelled. Claims 19, 20, 24, 25, 29 and 30 are pending.

Rejection of the claims

In the Office Action, independent claims 19, 20, 24, 25, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,003,719 ("Rosenoff").

Claim 19 recites:

19. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Serial No.: 09/690,366

Docket No. 1005.6
Customer No. 53953

Claim 20 recites:

20. A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes video image information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes displaying video images on the display device in response to the video image information and a selection of the first location by the user.

Claim 24 recites:

24. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Serial No.: 09/690,366

Docket No. 1005.6
Customer No. 53953

Claim 25 recites:

25. A system, comprising:
a computing device for:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes video image information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes displaying video images on the display device in response to the video image information and a selection of the first location by the user.

Claim 29 recites:

29. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detect a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embed a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user; and
apparatus from which the computer program is accessible by the computer system.

Serial No.: 09/690,366

Claim 30 recites:

30. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:
store a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detect a reference to a second location, wherein the second location is external to the paper, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embed a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes video image information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and
while the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes displaying video images on the display device in response to the video image information and a selection of the first location by the user; and
apparatus from which the computer program is accessible by the computer system.

MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to independent claims 19 and 20, Rosenoff is defective in establishing a prima facie conclusion of obviousness. As between Rosenoff and Applicant's specification, only

Serial No.: 09/690,366

Docket No. 1005.6
Customer No. 53953

Applicant's specification teaches the combinations of elements in claims 19 and 20. In fact, Rosenoff teaches away from such combinations. Contrary to claims 19 and 20, Rosenoff is focused on legal citations—e.g., references to court opinions, government laws, and legal treatises (see col. 2, lines 40-57)—and, accordingly, Rosenoff is nonanalogous.

Unlike Rosenoff, claim 19 requires: (a) in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes audio signal information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and (b) while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user. Consequently, in relation to claim 19, Rosenoff is defective in establishing a prima facie case of obviousness.

Unlike Rosenoff, claim 20 requires: (a) in response to the detected reference, embedding a hyperlink within the detected reference at the first location, wherein the second location is a file external to the paper, wherein the file includes video image information, and wherein the hyperlink is selectable at the first location by a user to cause an operation associated with the second location; and (b) while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable at the first location by the user to cause the operation associated with the second location, wherein the operation includes displaying video images on the display device in response to the video image information and a selection of the first location by the user. Consequently, in relation to claim 20, Rosenoff is defective in establishing a prima facie case of obviousness.

In relation to claims 24, 25, 29 and 30, Rosenoff is likewise defective in establishing a prima facie case of obviousness. Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of claims 19, 20, 24, 25, 29 and 30 is not supported.

Serial No.: 09/690,366

Docket No. 1005.6
Customer No. 53953**Conclusion**

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 19, 20, 24, 25, 29 and 30.


To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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